

REMARKS

Of claims 1-5 pending in this application, claims 1-5 have been amended and new claims 6-12 have been added. In addition, the specification was amended in several places to correct typographical errors. Reconsideration of this application in view of this response is respectfully requested.

The drawings have been objected to, as FIG. 1 should be designated by a legend such as -- Prior Art -- because only that which is old is illustrated. A correct drawing sheet in compliance with 37 CFR § 1.121(d) is submitted with this amendment. A replacement sheet labeled "Replacement Sheet" has been submitted, along with a sheet marked up in red showing the changes made. Upon allowance of the application, a formal drawing sheet will be submitted.

Claim 3 stands rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As claim 3 has been amended to depend from claim 2, it is believed that this rejection is now moot.

Claims 1, 4 and 5 stand rejected under 35 USC § 102(e) as being anticipated by Cohen et al. (6,454,806). The examiner states that Cohen et al. discloses an expandable bone device with first and second sections having outer surfaces for contacting bone; the device has adjusting means and activating means to cause the adjusting means to shift the first and second means to an expanded condition outward to contact the bone. Regarding claim 4, the activating means have tapered surfaces that correspond with tapered surfaces of

IN THE DRAWINGS

FIG. 1 of sheet 1 of the drawings has been amended to include the legend -- Prior Art --, as that which is illustrated in the figure is prior art. It is submitted that there is support in the original drawings, specification and claims for this change, and that no new matter has been added by this change.

A replacement sheet labeled as such has been included with this amendment, along with a copy of the original sheet showing the changes in red. Upon allowance of the application, a new formal drawing, including the change, will be submitted.

the first and second sections. Regarding claim 5, the wedges are part of the prosthesis and are held tightly within the two sections.

The device taught in Cohen et al. is a spinal surgical prosthesis, it is not an arthroplasty device. It is intended to be inserted between vertebrae in the spine to achieve fusion of the inter-vertebral space. It is not designed to fill the intramedullary canal of a bone.

Amended claim 1 now requires a prosthesis for implantation into the intramedullary canal of a bone and an expandable arthroplasty device for holding the prosthesis. Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulson, 30 F. 3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994). The corollary of this rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedstick AB v. Crucible, Inc., 793 F. 2d. 1565, 230 USPQ 81 (Fed. Cir. 1986). Since Cohen et al. fails to teach or otherwise disclose the presently claimed prosthesis for implantation into the intramedullary canal of a bone along with an expandable arthroplasty device for holding the prosthesis, it cannot anticipate claim 1. Therefore, the rejection of claim 1 under 35 USC § 102 under Cohen et al. is overcome and reconsideration is respectfully requested.

As claim 2 depends directly from claim 1, it is patentable if claim 1 is patentable. With respect to claim 3, the Examiner has stated that it would be allowable if rewritten to overcome the § 112 rejection. As this has been done, claim 3 should be allowable. With respect to claim 5, as this claim ultimately depends from claim 1, it is patentable if claim 1 is patentable.

Claim 1 also stands rejected under 35 USC § 102(e) as being anticipated by Young et al. (6,190,414). The examiner states that Young et al. discloses an expandable bone device with first and second sections having outer surfaces for contacting bone, and includes adjusting means and activating means at the end sections.

Again, the device taught in Young et al., like Cohen et al., is a spinal surgical prosthesis for facilitating the fusion of adjacent vertebrae in the spine; it is not an arthroplasty device, nor is it designed to fill the intramedullary canal of a bone.

As amended claim 1 now requires a prosthesis for implantation into the intramedullary canal of a bone and an expandable arthroplasty device for holding the prosthesis. Since Young et al. fails to teach or otherwise disclose the presently claimed combination, it cannot anticipate claim 1, and the § 102 rejection is overcome. Reconsideration of this rejection is respectfully requested.

Claim 2 stands rejected under 35 USC § 103(a) as being unpatentable over Young et al. '414. As claim 2 depends from claim 1, it is patentable if claim 1 is patentable.

CONCLUSION

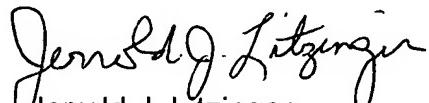
Applicant respectfully requests that this Response be entered by the Examiner, placing all pending claims in condition for allowance. Applicant submits that this response does not raise new issues or necessitate an additional search of the art by the Examiner.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite the prosecution.

It is believed that no fee is due with the filing of this response, as the claims added did not exceed the minimum already paid for. If a fee is due, please charge the fee to deposit Account No. 12-677. If a fee is required for an extension of time under 37 CFR § 1.136 not accounted for, such an extension is requested and the fee should be charged to the aforementioned Deposit Account.

For the reasons given above, it is believe that all claims now contained in this application are in condition for allowance, and such favorable action is respectfully requested.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on MAY 9, 2005.

ALEXANDRIA, VA 22313

JERROLD J. LITZINGER
Person Signing Certificate

Jerrold J. Litzinger
Signature of Person Signing
Certificate

May 9, 2005
Date of Signature

TITLE: EXPANDING ARTHROPLASTY DEVICES
INVENTOR: BRET A. FERREE
SN: 10/608,666; DOCKET: SP113.1
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ANNOTATED MARKED UP DRAWING

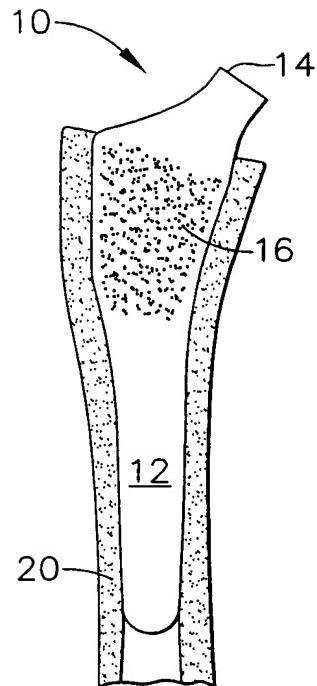


FIG. 1

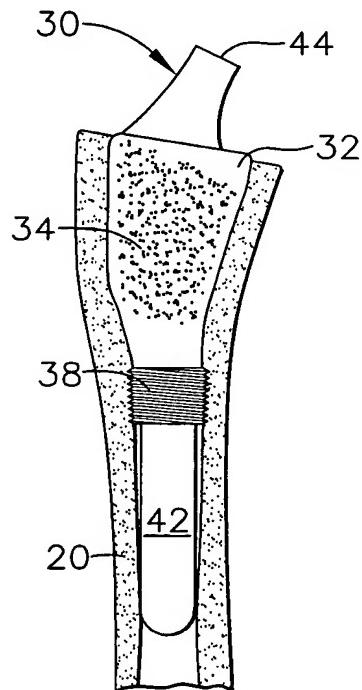


FIG. 2

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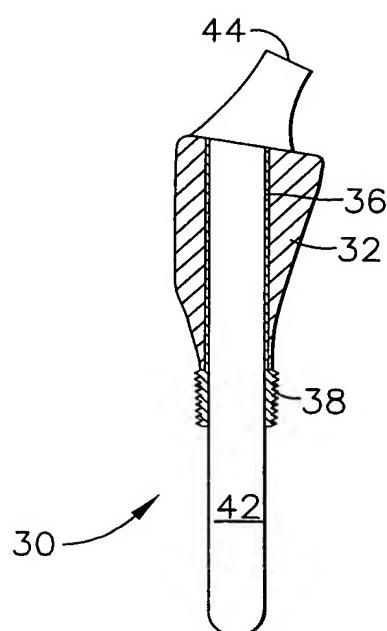
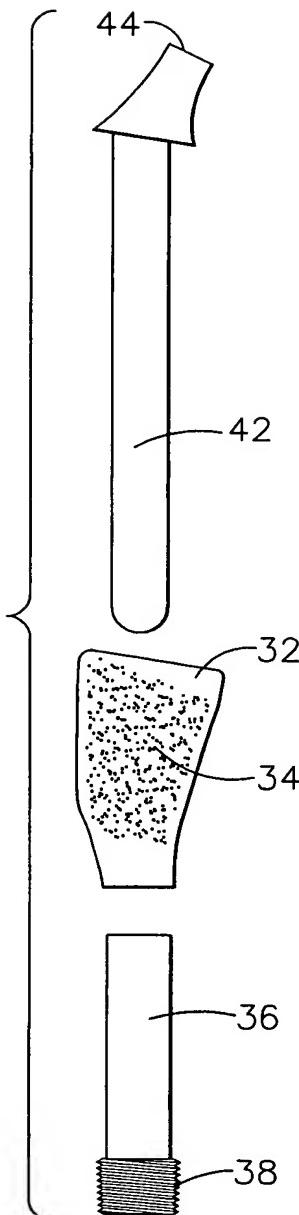


FIG. 3

FIG. 4

PRIOR ART